

REMARKS

By this amendment, the claims 1-3, 8, 9 and 12-14 have been amended. Claims 20-21 were previously canceled. Claims 1-19 remain in the application. Support for the amendments can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is requested.

Rejection under 35 U.S.C. §102

Claim 1 recites a method for managing the recording capacity of a recording device when scheduling the recording of an item, independently of user involvement, comprising:

- receiving data representing a plurality of recording modes of the recording device;
- for each recording mode, calculating the capacity required to record said item using said mode;
- obtaining a prevailing unreserved recording capacity of the recording device;
- identifying a number of recording modes of the plurality for the recording of said item for which the calculated capacity is less than the prevailing unreserved recording capacity; and
- where one or more recording modes of the plurality are identified for the recording of said item,
 - o selecting an identified recording mode of the one or more identified recording modes based on a preference; and
 - o responsive to an identified recording mode being selected, scheduling the recording of said item using the selected recording mode, wherein the scheduled recording of said item becomes a reserved item.

Support for the amendments to claim 1 (as well as for claim 3 and 13) can be found in

the specification at least on page 6, line 18 to page 7, line 5; page 9, lines 1-5; page 16, lines 15-23; and Figures 1a and 1b.

Claims 1 and 12 were rejected under 35 U.S.C. §102(e) as being anticipated by **Gunji** et al. (US 7,212,725, hereinafter referred to as "**Gunji**"). Applicant respectfully traverses this rejection for at least the following reasons.

The PTO provides in MPEP § 2131 that
"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, with respect to claim 1, to sustain this rejection the **Gunji** reference must contain all of the above claimed elements of the respective claims. However, contrary to the examiner's position that all elements are disclosed in the **Gunji** reference, the latter reference does not disclose "scheduling the recording of an item, independently of user involvement ... obtaining a prevailing unreserved recording capacity of the recording device ... identifying a number of *recording modes* of the plurality for the recording of said item for which the calculated capacity is less than the prevailing unreserved recording capacity; and *where* one or more recording modes of the plurality are *identified* for the recording of said item ... selecting an identified recording mode of the one or more identified recording modes *based on a preference*; and responsive to an identified recording mode being *selected*, scheduling the recording of said item using the selected recording mode, wherein the scheduled recording of said item becomes a *reserved item*" [*emphasis added*] as is claimed in claim 1. Therefore, the rejection is not supported by the **Gunji** reference and should be withdrawn.

In contrast, the **Gunji** reference discloses a recording/reproducing apparatus and picture recording reservation method which requires **user involvement** throughout the **Gunji** reference, for example, as evidenced in at least column 8, line 46-47, which states "by the picture recording reservation key **operation of the user**"; column 9, lines 3-5, which states "a reservation information input position (row) is **set by moving a cursor**

311 on the left side”; and column 10, lines 6-7, which states “the **user can easily confirm** the reliability of the picture recording reservation”; and column 10, lines 56-57, which states “the **user makes mode selection** and moves the cursor to a desired row.”

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claim 12 depends from and further limits independent claim 1 and therefore is allowable as well. The 35 U.S.C. §102(e) rejection thereof has now been overcome.

Rejection under 35 U.S.C. §103

Claims 2-10 and 13-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Gunji** et al. (US 7,212,725, hereinafter referred to as “**Gunji**”) in view of Imada et al. (US 7,254,318, hereinafter referred to as “**Imada**”).

With respect to claims 2, 9 and 10, the rejection is respectfully traversed for at least the following reason. Claims 2, 9 and 10 depend from and further limit allowable independent claim 1 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

With respect to claim 3, this rejection is traversed for at least the following reasons.

Claim 3 recites a method for managing the recording capacity of a recording device when recording an item, independently of user involvement, comprising:

- receiving data representing a plurality of recording modes of the recording device;
- selecting a recording mode of the plurality of recording modes based on a preference;

- commencing the recording of said item using the selected recording mode; and
- while recording the item:
 - o obtaining a prevailing unreserved recording capacity of the recording device; and
 - o responsive to the prevailing unreserved recording capacity for recording of said item using the selected recording mode being less than a pre-determined amount, adapting at least one reserved item, wherein any initial portion of said item already recorded using the selected recording mode becomes a reserved item subject to being adapted; and
 - o determining whether recording of said item is finished, wherein (i) responsive to being finished, ending the recording, and (ii) responsive to being unfinished, continuing the recording commencing with the obtaining step.

Support for the amendments to claim 3 (as well as for claim 13) can be found in the specification at least on page 6, line 18 to page 7, line 5; page 9, lines 1-5; page 16, lines 15-23; and Figures 1a and 1b.

Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 3.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Gunji** and **Imada** patents cannot be applied to reject claim 3 under 35 U.S.C. §103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Gunji** nor **Imada** teaches managing the recording capacity of a recording device when recording an item “independently of user involvement ... obtaining a prevailing unreserved recording capacity of the recording device ... responsive to the prevailing unreserved recording capacity for recording of said item using the selected recording mode being less than a pre-determined amount, adapting at least one reserved item, wherein any *initial portion* of said item already recorded using the selected recording mode becomes a *reserved item* subject to being adapted; and determining whether recording of said item is finished, wherein (i) responsive to being *finished, ending* the recording, and (ii) responsive to being *unfinished, continuing* the recording commencing with the *obtaining step*” as is claimed in claim 3, it is impossible to render the subject matter of claim 3 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

In the present case, the **Gunji** reference, by necessitating user involvement, for example, as evidenced in at least column 8, line 46-47, which states “by the picture recording reservation key **operation of the user**”; column 9, lines 3-5, which states “a reservation information input position (row) is **set by moving a cursor 311** on the left side”; and column 10, lines 6-7, which states “the **user can easily confirm** the reliability of the picture recording reservation”; and column 10, lines 56-57, which states “the **user makes mode selection** and moves the cursor to a desired row” teaches away from the recording of an item, independently of **user involvement**. Thus, this system clearly teaches away from claim 3, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, *arguendo*, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another compelling reason why the **Gunji** and **Imada** patents cannot be applied to reject claim 3 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown

and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither **Gunji** nor **Imada** teaches, or even suggests, the desirability of the combination since neither teaches the specific managing the recording capacity of a recording device when recording an item "independently of **user involvement** ... obtaining a prevailing unreserved recording capacity of the recording device ... responsive to the prevailing unreserved recording capacity for recording of said item using the selected recording mode being less than a pre-determined amount, adapting at least one reserved item, wherein any *initial portion* of said item already recorded using the selected recording mode becomes a *reserved item* subject to being adapted; and determining whether recording of said item is finished, wherein (i) responsive to being *finished*, ending the recording, and (ii) responsive to being *unfinished*, continuing the recording commencing with the *obtaining step*" as specified above and as claimed in claim 3.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 3. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of

obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

With respect to claims 4-8, the rejection is respectfully traversed for at least the following reason. Claims 4-8 depend from and further limit allowable independent claim 3 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

With respect to claim 13, this rejection is respectfully traversed for at least the following reason. Claim 13 has been amended in a similar manner as the amendments to claims 1 and 3. For reasons similar to those presented herein above with respect to overcoming the rejection of claim 3, claim 13 is believed allowable and the rejection under 35 U.S.C. §103 should be withdrawn.

With respect to claims 14-17, the rejection is respectfully traversed for at least the following reason. Claims 14-17 depend from and further limit allowable independent claim 13 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over **Gunji** et al. (US 7,212,725, hereinafter referred to as "**Gunji**"), in view of Imada et al. (US 7,254,318, hereinafter referred to as "**Imada**"), further in view of **Ellis** et al (US 2002/0174430, hereinafter referred to as "**Ellis**").

With respect to claim 11, the rejection is respectfully traversed for at least the following reason. Claim 11 depends from and further limits allowable independent claim 1 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

Claims 18-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Gunji** et al. (US 7,212,725, hereinafter referred to as "**Gunji**"), and well known prior art.

With respect to claims 18-19, the rejection is respectfully traversed for at least the following reason. Claims 18-19 depend from and further limit allowable independent claim 13 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 3 and 13 are in condition for allowance. Claims 2 and 10-12 depend from and further limit independent claim 1 and therefore are allowable as well. Claims 4-9 depend from and further limit independent claim 3 and therefore are allowable as well. Claims 14-19 depend from and further limit independent claim 13 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-19 is requested.

Respectfully submitted,

/Michael J. Balconi-Lamica/

Michael J. Balconi-Lamica
Registration No. 34,291
for Edward Goodman, Reg. No. 28,613

Dated: 2009-05-12
Philips Intellectual Property & Standards
345 Scarborough Road
Briarcliff Manor, New York 10510
Telephone: 914-333-9611
Facsimile: 914-332-0615
File: GB030095US1

a-32658.262